

REMARKS:

Claims 1-53 are currently pending in the application.

Claims 1-53 stand rejected under 35 U.S.C. § 101.

Claims 1-53 stand rejected under 35 U.S.C. § 112, second paragraph.

Claims 1, 2, 10-12, 18, 19, 27-29, 35, 36, 44-46, and 52 stand rejected under 35 U.S.C. § 102(e) over U.S. Patent No. 6,996,589 to Jayaram et al. ("*Jayaram*").

Claims 16, 17, 33, 34, 50, and 51 stand rejected under 35 U.S.C. § 103(a) over *Jayaram*.

Claims 3, 20, 37, and 53 stand rejected under 35 U.S.C. § 103(a) over *Jayaram* in view of U.S. Publication No. 2002/0046301 to Shannon et al. ("*Shannon*").

Claims 4-6, 21-23, 25, 38-40 and 42 stand rejected under 35 U.S.C. § 103(a) over *Jayaram* in view of U.S. Patent No. 6,381,709 to Casagrande et al. ("*Casagrande*").

Claims 13-15, 30-32, and 47-49 stand rejected under 35 U.S.C. § 103(a) over *Jayaram* in view of U.S. Publication No. 2003/0233249 to Walsh et al. ("*Walsh*").

Claims 7, 9, 24, 26, 41, and 43 stand rejected under 35 U.S.C. § 103(a) over *Jayaram* in view of *Casagrande* and in further view of *Walsh*.

The Applicants respectfully submit that all of the Applicants arguments and amendments are without prejudice or disclaimer. In addition, the Applicants have merely discussed example distinctions from the cited prior art. Other distinctions may exist, and as such, the Applicants reserve the right to discuss these additional distinctions in a future Response or on Appeal, if appropriate. The Applicants further respectfully submit that by not responding to additional statements made by the Examiner, the Applicants do not acquiesce to the Examiner's additional statements. The example distinctions discussed by the Applicants are considered sufficient to overcome the Examiner's rejections. In

addition, the Applicants reserve the right to pursue broader claims in this Application or through a continuation patent application. No new matter has been added.

REJECTION UNDER 35 U.S.C. § 101:

Claims 1-53 stand rejected under 35 U.S.C. § 101 as allegedly being directed towards non-statutory subject matter. The Applicants respectfully disagree.

Nonetheless, the Applicants have amended independent Claims 1, 18, 35, 52, and 53 to more particularly point out and distinctly claim the subject matter of Applicants invention. In addition, the Applicants respectfully submit that amended independent Claims 1, 18, 35, 52, and 53 are directed to patentable subject matter and are clearly directed to patentable subject matter. The Applicants further respectfully submit that these amendments are not considered narrowing or necessary for patentability. By making these amendments, the Applicant does not indicate agreement with or acquiescence to the Examiner's position with respect to the rejections of these claims under 35 U.S.C. § 101, as set forth in the Office Action.

For at least these reasons, Applicants respectfully submit that Claims 1-53 are directed to statutory subject matter. The Applicants further respectfully submit that Claims 1-53 are in condition for allowance. Therefore, the Applicants respectfully request that the rejection of Claims 1-53 under 35 U.S.C. § 101 be reconsidered and that Claims 1-53 be allowed.

REJECTION UNDER 35 U.S.C. § 112 SECOND PARAGRAPH:

Claims 1-53 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Applicant respectfully disagrees.

Nonetheless, the Applicants have amended Claims 1, 12, 18, 29, 35, 46, 52, and 53 to more particularly point out and distinctly claim the subject matter of Applicants

invention. By making these amendments, the Applicants do not indicate agreement with or acquiescence to the Examiner's position with respect to the rejections of these claims under 35 U.S.C. § 112, as set forth in the Office Action.

The Applicants respectfully submit that Claims 1-53 are considered to be in full compliance with the requirements of 35 U.S.C. § 112. The Applicants further respectfully submit that Claims 1-53 are in condition for allowance. Thus, the Applicants respectfully request that the rejection of Claims 1-53 under 35 U.S.C. § 112 be reconsidered and that Claims 1-53 be allowed.

REJECTION UNDER 35 U.S.C. § 102(e):

Claims 1, 2, 10-12, 18, 19, 27-29, 35, 36, 44-46, and 52 stand rejected under 35 U.S.C. § 102(e) over *Jayaram*. The Applicants respectfully disagree.

By this amendment, the Applicants have amended Claims 1, 12, 18, 29, 35, 46, 52, and 53 to more particularly point out and distinctly claim the Applicants invention. By making these amendments, the Applicants do not indicate agreement with or acquiescence to the Examiner's position with respect to the rejections of these claims under 35 U.S.C. § 102(e), as set forth in the Office Action.

The Applicants respectfully submit that the ***amendments to independent Claims 1, 18, 35, 52, and 53 have rendered moot the Examiner's rejection of these claims and the Examiner's arguments in support of the rejection of these claims.*** The Applicants further respectfully submit that amended independent Claims 1, 18, 35, 52, and 53 in their current amended form contain unique and novel limitations that are not taught, suggested, or even hinted at in *Jayaram*. Thus, the Applicants respectfully traverse the Examiner's rejection of Claims 1, 2, 10-12, 18, 19, 27-29, 35, 36, 44-46, and 52 under 35 U.S.C. § 102(e) over *Jayaram*.

Jayaram Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicant's Claims

For example, with respect to amended independent Claim 1, this claim recites:

A **computer-implemented system for executing bulk data transfers between persistent data stores in connection with an enterprise-level business workflow**, comprising:

a **data integration server** coupled to one or more persistent data stores, the data integration server comprising:

one or more programmatic source interfaces, each being associated with a corresponding source data store, defined according to a common programmatic source interface specification, and exposed within the data integration server during a bulk data transfer in connection with an enterprise-level business workflow to enable the data integration server to extract from the corresponding source data store one or more data entities for loading into any one or more selected target data stores during the bulk data transfer; and

one or more programmatic target interfaces, each being associated with a corresponding target data store, defined according to a common programmatic target interface specification, and exposed within the data integration server during the bulk data transfer in connection with an enterprise-level business workflow to enable the data integration server to load into the corresponding target data store the one or more data entities extracted from any one or more selected source data stores during the bulk data transfer,

wherein each of the one or more programmatic source interfaces and the one or more programmatic target interfaces is operable to:

provide to the corresponding source and target data stores an abstraction of bulk data transfer operations within the data integration server such that custom code need not be developed in connection with the corresponding source and target data stores to enable bulk data transfers between the corresponding source and target data stores and any other persistent data store coupled with the data integration server; and

isolate from the data integration server specific details associated with the corresponding source and target data stores such that custom code need not be developed in connection with the data integration server to enable bulk data transfers between the corresponding source and target data stores and any other persistent data store coupled with the data integration server. (Emphasis Added).

In addition, *Jayaram* fails to disclose each and every limitation of amended independent Claims 18, 35, and 53.

The Applicants respectfully submit that *Jayaram* fails to disclose, teach, or suggest amended independent Claim 1 limitations regarding a “**computer-**

implemented system for executing bulk data transfers between persistent data stores in connection with an enterprise-level business workflow” and in particular *Jayaram* fails to disclose, teach, or suggest amended independent Claim 1 limitations regarding a “**data integration server** coupled to one or more persistent data stores”. In particular, the Examiner equates the “**data integration server**” recited in amended independent Claim 1 with the “**database conversion engine**” disclosed in *Jayaram*. (13 September 2007 Final Office Action, Page 4). However, **the database conversion engine disclosed in Jayaram** merely comprises computer executable instructions, but **does not include, involve, or even relate to the data integration server**, as recited in amended independent Claim 1. (Column 10, Lines 56-63). In contrast, the “**data integration server**” recited in amended independent Claim 1 **is coupled with one or more persistent data stores and comprises one or more programmatic source interfaces and one or more programmatic target interfaces**. Thus, the Applicants respectfully submit that the equations forming the foundation of the Examiner’s comparison between *Jayaram* and amended independent Claim 1 cannot be made. The Applicants further respectfully submit that these distinctions alone are sufficient to patentably distinguish amended independent Claim 1 from *Jayaram*.

The Applicants respectfully submit that *Jayaram* fails to disclose, teach, or suggest amended independent Claim 1 limitations regarding “**one or more programmatic source interfaces**, each being associated with a corresponding source data store, defined according to a common programmatic source interface specification, and exposed within the data integration server during a bulk data transfer in connection with an enterprise-level business workflow to enable the data integration server to extract from the corresponding source data store one or more data entities for loading into any one or more selected target data stores during the bulk data transfer” and “**one or more programmatic target interfaces**, each being associated with a corresponding target data store, defined according to a common programmatic target interface specification, and exposed within the data integration server during the bulk data transfer in connection with an enterprise-level business workflow to enable the data integration server to load into the corresponding target data store the one or more data

entities extracted from any one or more selected source data stores during the bulk data transfer”.

In particular, the Examiner equates the “**one or more programmatic source interfaces**” recited in amended independent Claim 1 with the “**data filter 234**” disclosed in *Jayaram* and equates the “**one or more programmatic target interfaces**” recited in amended independent Claim 1 with a “**final upload process 270**” disclosed in *Jayaram*. (13 September 2007 Final Office Action, Page 4). However, the “**data filter 234**” disclosed in *Jayaram* merely converts source data from a fixed format to an XML and the “**final upload process 270**” disclosed in *Jayaram* **is merely an upload process that may be provided to only load** the target data into the database, but **does not include, involve, or even relate to the one or more programmatic source interfaces or the one or more programmatic target interfaces**, as recited in amended independent Claim 1. (Column 12, Lines 4-33).

In contrast, the “**one or more programmatic source interfaces**” recited in amended independent Claim 1 are each associated with a corresponding source data store, defined according to a common programmatic source interface specification, and exposed within the data integration server during a bulk data transfer in connection with an enterprise-level business workflow which enable the data integration server to extract from the corresponding source data store one or more data entities for loading into any one or more selected target data stores during the bulk data transfer. Further in contrast, the “**one or more programmatic target interfaces**” recited in amended independent Claim 1 are each associated with a corresponding target data store, defined according to a common programmatic target interface specification, and exposed within the data integration server during the bulk data transfer in connection with an enterprise-level business workflow to enable the data integration server to load into the corresponding target data store the one or more data entities extracted from any one or more selected source data stores during the bulk data transfer”. Thus, the Applicants respectfully submit that the equations forming the foundation of the Examiner’s comparison between *Jayaram* and amended independent Claim 1 cannot

be made. The Applicants further respectfully submit that these distinctions alone are sufficient to patentably distinguish amended independent Claim 1 from *Jayaram*.

The Office Action Fails to Properly Establish a *Prima Facie* case of Anticipation over *Jayaram*

The Applicants respectfully submit that the allegation in the present Office Action that *Jayaram* discloses all of the claimed features is respectfully traversed. Further, it is noted that the Office Action provides no concise explanation as to how *Jayaram* is considered to anticipate ***all of the limitations*** in Claims 1, 2, 10-12, 18, 19, 27-29, 35, 36, 44-46, and 52. ***A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if each and every element of a claimed invention is identically shown in that single reference.*** MPEP § 2131. (Emphasis Added).

With respect to the subject application, the Examiner has not adequately supported the rejection under 35 U.S.C. § 102, because the Examiner has not shown how each and every element of the Applicants claimed invention is identically shown in *Jayaram*. For example, the Examiner asserts that the “***data integration server***”, in amended independent Claim 1 is somehow equivalent to a ***database conversion engine***. (13 September 2007 Final Office Action, Page 4). The Applicants respectfully disagree and further respectfully request clarification as to how the Examiner arrives at this conclusion. In another example, the Examiner asserts that “***one or more programmatic source interfaces***”, in amended independent Claim 1 is somehow equivalent to ***data filter 234***. (13 September 2007 Final Office Action, Page 4). The Applicants respectfully disagree and further respectfully request clarification as to how the Examiner arrives at this conclusion. In still another example, the Examiner asserts that “***one or more programmatic target interfaces***”, in amended independent Claim 1 is somehow equivalent to ***final upload process 270***. (13 September 2007 Final Office Action, Page 4). The Applicants respectfully disagree and further respectfully request clarification as to how the Examiner arrives at this conclusion.

The Applicants respectfully points out that "it is incumbent upon the examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied

reference." Ex parte Levy, 17 U.S.P.Q.2d (BNA) 1461, 1462 (Pat. & Tm. Off. Bd. Pat. App. & Int. 1990). The Applicants respectfully submits that ***the Office Action has failed to establish a prima facie case of anticipation in Claims 1, 2, 10-12, 18, 19, 27-29, 35, 36, 44-46, and 52 under 35 U.S.C. § 102 with respect to Jayaram because Jayaram fails to identically disclose each and every element of the Applicants claimed invention, arranged as they are in Applicants claims.***

The Applicants Claims are Patentable over Jayaram

Amended independent Claims 18, 35, and 52 are considered patentably distinguishable over *Jayaram* for at least the reasons discussed above in connection with amended independent Claim 1.

Furthermore, with respect to dependent Claims 2, 10-12, 19, 27-29, 36, and 44-46: Claims 2 and 10-12 depend from amended independent Claim 1; Claims 19 and 27-29 depend from amended independent Claim 18; and Claims 36 and 44-46 depend from amended independent Claim 35 and are also considered patentably distinguishable over *Jayaram*. Thus, dependent Claims 2, 10-12, 19, 27-29, 36, and 44-46 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

Thus, for at least the reasons set forth herein, the Applicants respectfully submit that Claims 1, 2, 10-12, 18, 19, 27-29, 35, 36, 44-46, and 52 are not anticipated by *Jayaram*. The Applicants further respectfully submit that Claims 1, 2, 10-12, 18, 19, 27-29, 35, 36, 44-46, and 52 are in condition for allowance. Thus, the Applicants respectfully request that the rejection of Claims 1, 2, 10-12, 18, 19, 27-29, 35, 36, 44-46, and 52 under 35 U.S.C. § 102 (e) be reconsidered and that Claims 1, 2, 10-12, 18, 19, 27-29, 35, 36, 44-46, and 52 be allowed.

THE LEGAL STANDARD FOR ANTICIPATION REJECTIONS UNDER 35 U.S.C. § 102:

The following sets forth the legal standards for "anticipation."

The events that can lead to anticipation can be divided into the following seven categories, all defined by statute:

1. Prior Knowledge: The invention was publicly known in the United States before the patentee invented it.

2. Prior Use: The invention was publicly used in the United States either (i) before the patentee invented it; or (ii) more than one year before he filed his patent application.

3. Prior Publication: The invention was described in a printed publication anywhere in the world either (i) before the patentee invented it; or (ii) more than one year before he filed his patent application.

4. Prior Patent: The invention was patented in another patent anywhere in the world either (i) before the patentee invented it; or (ii) more than one year before he filed his application.

5. On Sale: The invention was on sale in the United States more than one year before the patentee filed his application.

6. Prior Invention: The invention was invented by another person in the United States before the patentee invented it, and that other person did not abandon, suppress or conceal the invention.

7. Prior U.S. Patent: The invention was described in a patent granted on a patent application filed in the United States before the patentee made the invention.

Each of those seven events has its own particular requirements, but they all have the following requirements in common:

1. Anticipation must be shown by clear and convincing evidence.
2. If one prior art reference completely embodies the same process or product as any claim, the product or process of that claim is anticipated by the prior art, and that

claim is invalid. To decide whether anticipation exists, one must consider each of the elements recited in the claim and determine whether all of them are found in the particular item alleged to be anticipating prior art.

3. There is no anticipation unless every one of those elements is found in a *single* prior publication, prior public use, prior invention, prior patent, prior knowledge or prior sale. One may not combine two or more items of prior art to make out an anticipation. One should, however, take into consideration, not only what is expressly disclosed or embodied in the particular item of prior art, but also what inherently occurred in its practice.

4. There cannot be an accidental or unrecognized anticipation. A prior duplication of the claimed invention that was accidental, or unrecognized, unappreciated, and incidental to some other purpose is not an invalidating anticipation.

Those four requirements must be kept in mind and applied to each kind of anticipation in issue. The following additional requirements apply to some categories of anticipation.

1. Prior Knowledge: An invention is anticipated if it was known by others in the United States before it was invented by the patentee. "Known," in this context, means known to the public. Private knowledge, secret knowledge or knowledge confined to a small, limited group is not necessarily an invalidating anticipation. Things that were known to the public only outside the United States are not invalidating anticipation.

2. Prior Use: An invention is anticipated if it was used by others before it was invented by the patentee, or more than one year before the patentee filed his patent application. "Use," in this context, means a public use.

3. Prior Publication: A patent is invalid if the invention defined by the Claims was described in a printed publication before it was invented by the patentee or more than one year prior to the filing date of his application. For a publication to constitute an anticipation of an invention, it must be capable, when taken in conjunction with the knowledge of people of ordinary skill in the art, of placing the invention in the possession

of the reader. The disclosure must be enabling and meaningful. In determining whether the disclosure is complete, enabling, and meaningful, one should take into account what would have been within the knowledge of a person of ordinary skill in the art at the time, and one may consider other publications that shed light on the knowledge such a person would have had.

4. Prior Patent: If the invention defined by the claims was patented in the United States or a foreign country, either before it was invented by the inventor or more than one year before the inventor filed his patent application, then the invention was anticipated. The effective date for this type of anticipation is the date on which two things co-existed: (i) the owner of the referenced patent had the right to enforce that patent; and (ii) the reference patent was available to the public. What was "patented" in the reference patent is determined by what is defined by its claims, interpreted in the light of the general description.

5. On Sale: A patent is invalid if the invention claimed in it was on sale in the United States more than one year prior to the application filing date.

6. Prior Invention: If the invention defined by the claims was invented by another person, in the United States, before it was invented by the inventor, and that other person did not abandon, suppress, or conceal the invention, the invention lacks novelty. A prior invention, even if put in physical form and shown to produce the desired result, is not an invalidating anticipation unless some steps were taken to make it public. However, it is not necessary that the inventor had knowledge of that prior invention.

7. Prior U.S. Application: A patent is invalid for lack of novelty if the invention defined by the claims was described in a United States patent issued on a patent application filed by another person before the invention was made by the inventor. The effective date of a prior application for purposes of this issue is the date on which it was filed in the United States. Foreign-filed patent applications do not apply. If the issued United States patent claims the benefit of more than one United States application, its effective date as an anticipation is the filing date of the first United States application that discloses the invention claimed in that referenced patent.

Experimental Use Exception: The law recognizes that it is beneficial to permit the inventor the time and opportunity to develop his invention. As such there is an "experimental use" exception to the "public use" and "on sale" rules. Even though the invention was publicly used or on sale, more than one year prior to the application filing date, that does not invalidate the patent, provided the principal purpose was experimentation rather than commercial benefit. If the primary purpose was experimental, it does not matter that the public used the invention or that the inventor incidentally derived profit from it.

When a public use or sale is shown, the burden is on the inventor to come forward with evidence to support the experimental use exception. Only experimentation by or under the control of the inventor qualifies for this exception. Experimentation by a third party, for its own purposes, does not qualify for this exception. Once the invention leaves the inventor's control, its use is a public one, even if further experimentation takes place.

The experimentation must relate to the claimed features of the invention. And it must be for the purpose of technological improvement, not commercial exploitation. If any commercial exploitation does occur, it must be merely incidental to the primary purpose of experimentation. A test done primarily for marketing, and only incidentally for technological improvement, is a public use.

REJECTION UNDER 35 U.S.C. § 103(a):

Claims 16, 17, 33, 34, 50, and 51 stand rejected under 35 U.S.C. § 103(a) over *Jayaram*. Claims 3, 20, 37, and 53 stand rejected under 35 U.S.C. § 103(a) over *Jayaram* in view of *Shannon*. Claims 4-6, 21-23, 25, 38-40 and 42 stand rejected under 35 U.S.C. § 103(a) over *Jayaram* in view of *Casagrande*. Claims 13-15, 30-32, and 47-49 stand rejected under 35 U.S.C. § 103(a) over *Jayaram* in view of *Walsh*. Claims 7, 9, 24, 26, 41, and 43 stand rejected under 35 U.S.C. § 103(a) over *Jayaram* in view of *Casagrande* and in further view of *Walsh*. The Applicants respectfully disagree. Thus, the Applicants respectfully traverse the Examiner's obvious rejection of Claims 3-7, 9, 13-16, 17, 20-24, 25, 26, 30-33, 34, 37-41, 42, 43, 47-50, 51, and 53 under 35 U.S.C. § 103(a) over the

proposed combination of *Jayaram*, *Shannon*, *Casagrande*, or *Walsh*, either individually or in combination.

The Office Action Acknowledges that *Jayaram* Fails to Disclose Various Limitations Recited in Applicants Claims

The Applicants respectfully submit that the Office Action acknowledges, and the Applicants agree, that *Jayaram* fails to disclose various limitations recited in amended independent Claim 1. Specifically the Examiner acknowledges that *Jayaram* fails to teach “isolating transformation logic from defined programmatic interfaces”, “JAVA interfaces”, “industry standard interface and industry standard protocol”, “industry standard File Transfer Protocol (FTP) interface and FTP industry standard protocol”, “Extract-Transform-Load (ETL) tool”, and “to support compatibility between any commercially available ETL tool”. (13 September 2007 Final Office Action, Pages 7-14). However, the Examiner asserts that the cited portions of *Shannon*, *Casagrande*, and *Walsh* disclose the acknowledged shortcomings in *Jayaram*. The Applicants respectfully traverse the Examiner’s assertions regarding the subject matter disclosed in *Shannon*, *Casagrande*, and *Walsh*.

The Office Action Fails to Properly Establish a *Prima Facie* case of Obvious over the Proposed *Jayaram-Shannon-Casagrande-Walsh* Combination

The Applicants respectfully submit that the Office Action fails to properly establish a *prima facie* case of obviousness based on the proposed combination of *Jayaram*, *Shannon*, *Casagrande*, or *Walsh*, either individually or in combination. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine these references as proposed. The Office Action merely states that “it would have been obvious to one having ordinary skill in the art at the time of the invention was made: that the transformation logic can be coded separately from logical relationship” and “to support ETL tool or any type of tools for the data stores”. (13 September 2007 Final Office Action, Pages 7-14). The Applicants respectfully disagree.

The Applicants further respectfully submit that this purported advantage relied on by the Examiner is nowhere disclosed, taught, or suggested in *Jayaram*, *Shannon*, *Casagrande*, or *Walsh*, either individually or in combination. The Examiner asserts that the motivation to combine the references as proposed would be: “because by doing so it would be easier to develop separate segments of codes in a complex software system”; “because *Shannon* teaching of JAVA interfaces would provide a greater ease of integration by allowing data to be mapped from one application to another application”; “because *Casagrande* teaching of industry standard protocol interface would enhance and make it easier for *Jayaram*’s system to transfer data between data stores using well known protocol such as FTP”; “in order to provide a data store independent system allowing data conversion from any source data stores into any target data stores”; and “because *Walsh*’s teaching of ETL tool would enhance the transfer mechanism in *Jayaram*’s and *Casagrande*’s systems by providing extraction of data from a data source”. (13 September 2007 Final Office Action, Pages 7-14). The Applicants respectfully disagree and further respectfully request clarification as to how the Examiner arrives at this conclusion. ***The Applicants respectfully request the Examiner to point to the portions of Jayaram, Shannon, Casagrande, or Walsh which contain the teaching, suggestion, or motivation to combine these references for the Examiner’s stated purported advantage.*** The Applicants further respectfully submit that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the ***prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art.*** *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. With respect to the subject Application, the ***Examiner has not adequately supported the selection and combination of Jayaram, Shannon, Casagrande, or Walsh to render obvious the Applicants claimed invention.*** The Examiner’s unsupported conclusory statements, ***do not adequately address the issue of motivation to combine.*** (13 September 2007

Final Office Action, Pages 7-14). This factual question of motivation is material to patentability, and cannot be resolved on subjective belief and unknown authority. *Id.* It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). Thus, ***the Office Action fails to provide proper motivation for combining the teachings of Jayaram, Shannon, Casagrande, or Walsh***, either individually or in combination.

The Applicants Claims are Patentable over the Proposed *Jayaram-Shannon-Casagrande-Walsh* Combination

The Applicants respectfully submit that as discussed above, amended independent Claims 1, 18, 35, and 52 are considered patentably distinguishable over *Jayaram*. In addition, the Applicants respectfully submit that amended independent Claim 53 is considered patentably distinguishable over *Jayaram* for at least the reasons discussed above in connection with amended independent Claims 1, 18, 35, and 52.

Furthermore, with respect to dependent Claims 3-7, 9, 13-16, 17, 20-24, 25, 26, 30-33, 34, 37-41, 42, 43, 47-50, and 51: Claims 3-7, 9, 13-16, and 17 depend from amended independent Claim 1; Claims 20-24, 25, 26, 30-33, and 34 depend from amended independent Claim 18; and Claims 37-41, 42, 43, 47-50, and 51 depend from amended independent Claim 35. As mentioned above, each of amended independent Claims 1, 18, 35, 52, and 53 are considered patentably distinguishable over the proposed combination of *Jayaram, Shannon, Casagrande, or Walsh*, either individually or in combination. Thus, dependent Claims 3-7, 9, 13-16, 17, 20-24, 25, 26, 30-33, 34, 37-41, 42, 43, 47-50, and 51 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

For at least the reasons set forth herein, the Applicants respectfully submit that Claims 3-7, 9, 13-16, 17, 20-24, 25, 26, 30-33, 34, 37-41, 42, 43, 47-50, 51, and 53 are not rendered obvious by the proposed combination of *Jayaram, Shannon, Casagrande, or Walsh*. The Applicants further respectfully submit that Claims 3-7, 9, 13-16, 17, 20-24, 25, 26, 30-33, 34, 37-41, 42, 43, 47-50, 51, and 53 are in condition for allowance. Thus, the

Applicants respectfully request that the rejection of Claims 3-7, 9, 13-16, 17, 20-24, 25, 26, 30-33, 34, 37-41, 42, 43, 47-50, 51, and 53 under 35 U.S.C. § 103(a) be reconsidered and that Claims 3-7, 9, 13-16, 17, 20-24, 25, 26, 30-33, 34, 37-41, 42, 43, 47-50, 51, and 53 be allowed.

THE LEGAL STANDARD FOR OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. § 103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, ***there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.*** Second, there must be a reasonable expectation of success. Finally, ***the prior art reference*** (or references when combined) ***must teach or suggest all the claim limitations.*** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, ***and not based on applicant's disclosure.*** *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, ***there must be something in the prior art as a whole to suggest the desirability,*** and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the

suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

CONCLUSION:

In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

Although the Applicants believe no fees are deemed to be necessary; the undersigned hereby authorizes the Director to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**. If an extension of time is necessary for allowing this Response to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777**.

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

13 November 2007
Date

/Steven J. Laureanti/signed
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